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precedent of the Board

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BERND FABRY,  
JOSEF KOESTER, HERMANN HENSEN  
AND KARL-HEINZ SCHMID

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Appeal No. 2004-0273  
Application 09/958,702

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ON BRIEF

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Before WINTERS, GRIMES, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 11-32.

Claims 11, 12, and 15 are representative of the subject matter on appeal, and are set forth below:

11. A composition comprising an emulsifier component containing:

- (a) a hydroxycarboxylic acid alkyl and/or alkenyl oligoglycoside ester; and
- (b) a fatty alcohol

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12. The composition of claim 11 wherein the hydroxycarboxylic acid alkyl and/or alkenyl oligoglycoside ester contains from about 1 to 50% by weight, based on the weight of the ester, of unesterified glycosides.

15. The composition of claim 11 wherein the hydroxycarboxylic acid alkyl and/or alkenyl oligoglycoside ester contains from about 5 to 25 % by weight, based on the weight of the ester, of unesterified glycosides.

Claims 11-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ansmann in combination with Garlisi.

The examiner relies upon the following references as evidence of unpatentability:

Ansmann et al. (Ansmann)	5,795,978	Aug. 18, 1998
Garlisi (EPO)	0 258 814	Apr. 28, 1993

#### **OPINION**

For the reasons set forth in the brief and reply brief, and below, we reverse the rejection.

The examiner's position is that Ansmann teaches emulsifiers for oil and water emulsions comprising from about 43% to 99% by weight of an alkyl and/or alkenyl oligoglycoside, and from about 1% to 57% by weight of a fatty alcohol. The examiner recognizes that Ansmann does not teach a hydroxycarboxylic acid alkyl and/or alkenyl oligoglycoside ester, as set forth in claim 11, and also the amount of unesterified glycosides, as set forth, for example, in claim 12. Answer, page 3.

The examiner relies upon Garlisi for teaching a hydroxycarboxylic acid alkyl and/or alkenyl oligoglycoside ester compound, and states that Garlisi teaches that such a compound is

useful in cosmetics for its surfactant properties, as well as other benefits. Answer, page 3.

The examiner concludes that it would have been obvious to have added the hydroxycarboxylic acid alkyl and/or alkenyl oligoglycoside ester compound of Garlisi to the composition of Ansmann. The examiner states that with respect to the amounts of components and the amount of unesterified glycoside, such amounts are optimizable variables, and absent unexpectedly good results, would have been obvious. (Answer, pages 3-4). On page 5 of the answer, the examiner also states that one of skill in the art would have been motivated to use the esters of Garlisi as the surfactants of Ansmann because of the expectation of achieving a pharmaceutical or cosmetic composition with the beneficial properties known to be realized.

Beginning on page 3 of the brief, appellants argue that Garlisi contains "absolutely no teaching or suggestion relating to the combination of said hydroxycarboxylic acid alkyl and/or alkenyl oligoglycoside esters with a fatty alcohol in order to realize a synergistic improvement in thickening and stability properties."

We find that Garlisi's use of the particularly disclosed esters is not used in combination with a fatty alcohol. Hence, we do not agree with the examiner's position that because (1) Ansmann teaches that additional surfactants can be added to Ansmann's composition, and because (2) Garlisi teaches that such esters can be used in cosmetic and pharmaceuticals, then sufficient motivation exists for the addition.

More particularly, we note that the initial burden of presenting a prima facie case of unpatentability on any ground rests with the examiner. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We also note that in order for a prima facie case of obviousness of the claimed

invention to be established, the prior art as applied must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out appellants' claimed invention and a reasonable expectation of success in so doing. See In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." Id. Also, "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Here, the examiner has not established that the skilled artisan would have found it obvious to combine Garlisi's particularly disclosed esters in the composition of Ansmann when Ansmann's composition includes fatty alcohols, while Garlisi's composition does not include fatty alcohols. That is, Garlisi's use of the particularly disclosed esters is not used in the context of a fatty alcohol containing composition. Adding Garlisi's particularly disclosed esters to the composition of Ansmann may have been obvious to try, but this does not constitute the standard for combining references under §103. In re Geiger, 815 F.2d at 687, 2 USPQ2d at 1278; cf. In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965).

Garlisi does teach use of hydroxycarboxylic acid alkyl and/or alkenyl oligoglycoside esters as surfactants. The esters are very efficient surfactants, having excellent detergent properties. See the paragraph bridging pages 5-6 of Garlisi. On page 6, at lines 13-14, Garlisi teaches that the esters prove to be compatible with most of known surfactants and therefore they may be formularized with them. Yet, Garlisi does not teach that in fact the disclosed esters would function as such when combined

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with a fatty alcohol. Also, Ansmann does not provide direction other than stating "the emulsions obtainable with the emulsifiers according to the invention may contain anionic, nonionic, cationic, and/or amphoteric or zwitterionic surfactants, as constituents. See column 4, lines 59-62. Ansmann lists examples of such constituents, beginning at the bottom of column 4 through column 5, line 38. Other auxiliaries and additives are also discussed, beginning at line 40 in column 5 through column 8 of Ansmann. None of the kinds of constituents or additives or auxiliaries discussed in Ansmann include the kinds of esters disclosed in Garlisi, to be combined with a fatty alcohol.

The examiner's position does not discuss how, in fact, the ester of Garlisi would function when combined with a fatty alcohol, especially in the context as to whether a reasonable expectation of success of so functioning would exist. Absent such an explanation by the examiner, we reverse the rejection.

#### **CONCLUSION**

The rejection of claims 11-32 under 35 U.S.C. § 103 as being unpatentable over Ansmann in combination with Garlisi is reversed.

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**REVERSED**

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
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ERIC GRIMES	)	INTERFERENCES
Administrative Patent Judge	)	
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BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	

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